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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,694	10/27/2000	Daniel J. Pugh	032001-074	6119

7590 11/03/2003

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EXAMINER
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MAI, TAN V

ART UNIT	PAPER NUMBER
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2124

DATE MAILED: 11/03/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

PRE

# **Office Action Summary**

Application N .

09/698,694

Applicant(s)

PUGH ET AL.

Examiner

Tan V Mai

Art Unit

2124

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## **Status**

- 1) ☒ Responsive to communication(s) filed on 8-18-03 & 9-9-03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 12-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 and 23-31 is/are allowed.
- 6) ☒ Claim(s) 12-22 and 32-35 is/are rejected.
- 7) ☒ Claim(s) 36-38 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## **Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## **Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## **Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. This application is in condition for allowance except for the following formal matters:

A substitute specification excluding claims is required pursuant to 37 CFR 1.125(a) because the "APPENDIX I" contains drawings and different lay out. See 37 CFR 1.58(a) below:

§ 1.58 Chemical and mathematical formulae and tables.

(a) The specification, including the claims, may contain chemical and mathematical formulas, but shall not contain drawings or flow diagrams. The description portion of the specification may contain tables; claims may contain tables either if necessary to conform to 35 U.S.C. 112 or if otherwise found to be desirable.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

2. The abstract of the disclosure is objected to because legal phraseology is used in this paragraph (i.e., "comprising"). Correction is required. See MPEP § 608.01(b).

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "converting a pseudo-random code generator specification into an equivalent representation", does not reasonably provide enablement for "the equivalent representation is such that no taps are within n spaces from the input". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to made and use the invention commensurate in scope with these claims.

The examiner notes that applicants **do** show the pseudo-random code generator has "taps used to calculate an output include at least one tap within n spaces from the input", e.g., see two pair decomposed "LFSRs" of Fig. 2. The Fig. [2] merely shows the "gold code generator" (60) is separated in two portions with some modification but they still have the "taps are within n spaces from the input". Clarification is requested.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Shimada '385 or Shimada '099.

As per independent claim 32, both Shimada disclose (e.g., see Shimada '385 Figs. 5 & 8-9 or Shimada '099 Figs. 2 & 4) pseudo-random number generators having n [parallel] linear feedback shift registers (LFSRs) to simultaneously output the desired outputs. It is noted that Shimada '385 and Shimada '099 do not specifically disclose the claimed "gold code" generator; however, Shimada '385 and Shimada '099 are pseudo-random number generators. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to design the claimed invention according to Shimada's teachings because the references are pseudo-random number generators having n [parallel] linear feedback shift registers as claimed.

As per dependent claim 33-35, the detail features are well known component(s) in the art.

5. Claims 36-38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cited references are art of interest.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan V. Mai whose telephone number is (703) 305-9761. The examiner can normally be reached on Tue-Fri from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki, can be reached on (703) 305-9662. The fax phone numbers for the organization where this application or proceeding is assigned are:

After-final (703) 746-7238

Official (703) 746-7239

Non-Official/Draft (703) 746-7240.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



TAN V. MAI  
PRIMARY EXAMINER